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09/413,348	10/06/1999	NORIHISA FUKUTOMI	Q56091	1912
7590 06/26/2008 SUGHRUE MION ZINN MACPEAK & SEAS 2100 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20037				
EXAMINER KIM, CHRISTOPHER S				
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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NORIHISA FUKUTOMI, MASAYUKI AOTA, and
OSAMU MATSUMOTO

Appeal No. 2007-4353
Application No. 09/413,348
Technology Center 3700

Decided: June 26, 2008

Before TERRY J. OWENS, LINDA E. HORNER and JOSEPH A.
FISCHETTI, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

The above identified application is being remanded to the Examiner under 37 C.F.R. § 41.50(a) for appropriate action with regard to the items indicated below.

1. On March 27, 2000 the Examiner issued an Office Action requiring Appellants to elect between plural species as follows:

Species A, figure 1; Species B, figure 2; Species C, figure 3;
Species D, figure 4; Species E, figure 5; and Species F, figure 6.

In this Office Action, the Examiner indicated “no claims are generic”.
(Office Action dated March 27, 2000, p. 1).

2. On April 27, 2000, Appellants responded to the requirement indicating that Appellants elect the species of Figure 1. (Response dated 5/1/2000). Appellants further stated that “[a]t least claims 6 and 2/6 are readable on Figure 1.”¹ In addition, Appellants argued that claim 6 was generic (Response 4/27/2000).

3. In the subsequent Office Action dated May 22, 2000, the Examiner acknowledged “Appellants’ election of Species A, figure 1 in Paper No. 7” and withdrew claims 3-5 as drawn to nonelected species. The Examiner further indicated that claim 6 will now be considered as a generic claim in response to Appellants’ arguments. (Office Action dated May 22, 2000, p. 2).

4. In a final Office action dated August 1, 2003, claims 2 and 6-9 were finally rejected under 35 U.S.C. § 102(e) as being anticipated by Reiter and under 35 U.S.C. § 102(b) as being anticipated by Asano. Thus, Appellants seek our review under 35 U.S.C. § 134 of the Examiner’s final rejection of claims 2 and 6-9.

5. However, claim 2 on appeal recites language which does not read on the elected Species of Figure 1. Claim 2 recites:

¹ Claims 7-9 were not yet pending in the application at the time of this response.

said elastic member being attached to a portion of said sleeve located near an end portion of said coil.

This language conflicts with Appellants' written description and drawings in that as seen in Figure 1, in exploded view, the elastic member 18 is housed within a groove 18a formed in the core 4 (Specification 6:23-26), and thus is not attached to a portion of the sleeve as required by claim 2. Thus, Appellants' description of the Species of Figure 1 as described in its Specification and Figure 1, conflicts with the requirements of claim 2 in that the elastic member is attached to the core via the groove 18a, and not to the sleeve 17.

We therefore REMAND this case to the Examiner for the purpose of amending claim 2 to read on the elected Species of Figure 1 as described in the Specification in accordance with the problem set forth above. The Examiner may comply with this remand by re-opening prosecution to address the above noted issue.

REMANDED

JRG

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